

REMARKS

Claims 1, 6, 7 and 28-36 remain pending in the present application. Claims 1, 31 and 33 have been amended. Claims 34-36 are new. Basis for the amendments and new claims can be found throughout the specification, claims and drawings originally filed.

REJECTION UNDER 35 U.S.C. § 112

Claims 1, 6, 7 and 28-33 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The claims have been amended to overcome the rejection. Reconsideration of the rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 103

Claims 1, 6, 7 and 31-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Carton, et al. (U.S. Pat. No. 3,666,288) in view of Furuya, et al. (U.S. Pat. No. 5,042,624). Claim 28 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Carton, et al. in view of Furuya, et al. as applied to Claim 1 above, and further in view of Bonenberger, et al. (U.S. Pat. No. 5,285,877). Claim 29 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Carton, et al. in view of Furuya, et al. and in view of Bonenberger, et al. as applied to Claims 1 and 28 above, and further in view of Fister, et al. (U.S. Pat. No. 4,518,058). Claim 30 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Carton, et al. in view of Furuya, et al. as

applied to Claim 1 above, and further in view of Fister, et al. (U.S. Pat. No. 4,518,058). Applicants respectfully traverse this rejection.

In order to establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Here the Examiner combines the teachings of Furuya, et al. with Carton, et al. to modify the piston of Carton, et al. with flow ports and compression and extension valves as taught by Furuya, et al. in order to optimize the damping between the vehicle body and the wheels. Applicants disagree.

Carton, et al. discloses a pneumatic spring 24 and not a damper 24 as suggested by the Examiner. As defined in column 2, lines 32-37 of Carton, et al., the lower end of the cylinder is sealed against the escape of air where the piston rod 38 passes through it. The air in the lower chamber 43 of the cylinder is maintained under high pressure and constitutes elastic medium for permitting play of the associated wheel relative to the frame. Thus, the addition of the flow path and valve assemblies to Carton, et al. is not suggested or taught by Carton, et al., since Carton, et al. teaches away from putting valve assemblies into the piston. Putting valve assemblies into the piston would eliminate the air spring in Carton, et al.

If the proposed amendment would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Here, the addition of the valve assemblies to the piston in Carton, et al. renders Carton, et al. unsatisfactory for its intended purpose as an air spring. The

addition of the valve assemblies eliminates the air spring since lower chamber 43 could no longer be maintained under high pressure to act as an air spring.

Thus, Applicants believe Claims 1, 31 and 33 patentably distinguish over the art of record. Likewise, Claims 6, 7, 28-30 and 32 which ultimately depend from one of these independent claims are also believed to patentably distinguish over the art of record. Reconsideration of the rejection is respectfully requested.

NEW CLAIMS

New Claims 34-36 are dependent claims which Applicants believe read on the elected invention. New Claims 34-36 are believed to properly further limit independent Claims 1, 31 and 33 by defining the sealed working chamber as not communicating with an external source of pressurized gas.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: December 20, 2005

By: 

Michael J. Schmidt, 34,007

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303
(248) 641-1600

MJS/pmg